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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,805	02/04/2004	Clay Fisher	SON5180.84A	3337

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EXAMINER

DAYE, CHELCIE L

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/771,805	Applicant(s) FISHER ET AL.	
	Examiner CHELCIE DAYE	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 17-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 17-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is issued in response to applicant's amendment filed February 15, 2011.
2. Claims 1-10 and 17-28 are presented. No claim added and claims 11-16 are cancelled.
3. Claims 1-10 and 17-28 are pending.
4. Applicant's arguments filed February 15, 2011, have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-10 and 17-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schleifer (US Patent No. 7,526,768) in view of LaRue (US Patent Application No. 2002/0133508), further in view of Searby (US Patent No. 5,412,402).**

Regarding Claims 1, 10, 17, 18, and 24-28, Schleifer discloses a method of tracking and synchronizing content across multiple devices, including a

plurality of client devices and a server (cols.3-4, lines 58-67 and 1-14, respectively, Schleifer), comprising:

receiving new content associated with a request submitted by a user (col.10, lines 63-65, Schleifer);

reviewing said new content in response to the request and comparing with existing content for which a record exists and which is a duplicate or related to said new content (col.10, lines 65-67, Schleifer)¹;

performing the request corresponding to said new content (col.10, lines 66-67, Schleifer).

However, Schleifer is not as detailed with respect to new content for which no record exists and automatically completing fields within said new content record based on information contained in the new content as well as information about the presence of duplicate or related content which is available on the multiple devices.

On the other hand, LaRue discloses new content for which no record exists (par [0146], LaRue) and automatically completing fields within said new content record based on information contained in the new content as well as information about the presence of duplicate or related content which is available on the multiple devices ([0153], LaRue). Schleifer and LaRue are analogous art because they are from the same field of endeavor for the synchronization of data. It would have been obvious to one of ordinary skill in the art at the time of the

invention to incorporate LaRue's teachings into the Schleifer system. A skilled artisan would have been motivated to combine in order to provide a synchronization technology which processes already-known data and shares the information in an intelligent manner.

Therefore, the combination of Schleifer in view of LaRue, disclose wherein new content without an existing record is compared with existing content having a corresponding record, and if the new content is at least similar to existing content, then the records from the existing content are utilized in completing the fields of the new content (par [0171], LaRue); and

updating the records of duplicate or related content with information about the new content associated with said new content record to synchronize all the content records (par [0062], LaRue).

While LaRue discusses the system displaying graphic images (see par [0078]), LaRue is not as detailed with respect to the content being image content, and said comparing includes image analysis between the new content and the existing content.

On the other hand, Searby discloses the content being image content, and said comparing includes image analysis between the new content and the existing content (col.5, lines 39-45 and col.4, lines 5-21, Searby). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Searby's teachings into the Schleifer and LaRue system. A skilled

¹ Examiner Notes: A further explanation of comparing the content with related content is explained within

artisan would have been motivated to combine in order to provide a plurality of alternate content.

Regarding Claim 2, the combination of Schleifer in view of LaRue, further in view of Searby, disclose a method further comprising:

receiving a copy, delete, or print request from a user corresponding to specific content within the existing content wherein duplicates of said specific content, or related to said specific content, are retained on a device across multiple devices configured for communicating with one another over a network (col.6, lines 29-35, Schleifer);

reviewing a record associated with the specific content in response to the request and analyzing the associated record to determine what duplicate or related content is available across the multiple devices (cols.7-8, lines 46-67 and 1-11, Schleifer);

transmitting a confirmation for the request in response to detecting the presence of any duplicate or related content (par [0194], LaRue); and

performing the request in response to receiving the request and instructions from the user in responding to said confirmation (par [0193], LaRue).

Regarding Claims 3, 4, and 20, the combination of Schleifer in view of LaRue, further in view of Searby, disclose a method further comprising:

receiving a copy, delete, or print request from a user corresponding to said specific content within the existing content wherein duplicates of said specific content, or related to said specific content, are retained on a device across multiple devices configured for communicating with one another over a network (col.6, lines 29-35, Schleifer);

reviewing a record associated with the specific content in response to the request and analyzing the associated record to determine what duplicate or related content is available across the multiple devices (cols.7-8, lines 46-67 and 1-11, Schleifer); and

determining utilization of any duplicate or related content based on a pre-established preference and the type of request which was received (par [0140], LaRue).

Regarding Claims 5 and 19, the combination of Schleifer in view of LaRue, further in view of Searby, disclose the method wherein image-content resolution is determined when comparing duplicate or related content (Abstract, Searby).

Regarding Claims 6 and 23, the combination of Schleifer in view of LaRue, further in view of Searby, disclose the method wherein each content record includes a field for indicating other content related to content associated with the content record (col.8, lines 32-44, Schleifer).

Regarding Claims 7 and 21, the combination of Schleifer in view of LaRue, further in view of Searby, disclose the method further comprising storing the pre-established preference in a storage device (par [0077], LaRue).

Regarding Claims 8 and 22, the combination of Schleifer in view of LaRue, further in view of Searby, disclose the method further comprising storing the new content record in a storage device (par [0129], LaRue).

Regarding Claim 9, the combination of Schleifer in view of LaRue, further in view of Searby, disclose the method wherein the confirmation is sought from the user for authorization for executing the request (par [0194], LaRue).

Response to Arguments

Applicant argues, LaRue does not teach “content for which no record exists”.

Examiner respectfully disagrees. LaRue teaches the synchronization of records wherein the synchronizer determines a record that corresponds to the received changed client record, which if no such already-mapped record exists, the synchronizer creates a new and empty record and maps the received and changed record to the new record (par [0146]). Thus, clearly stating that a record does not exist and the system creates a record. The applicant argues that LaRue's non-existent record does not constitute the claimed “no record” existing because the record existed on another device. The

examiner does not agree with the applicant's interpretation of the reference and more so the examiner believes that with a broad interpretation of the claims the LaRue reference reads directly on the claim language.

Applicant argues that the limitation for claim 18 has no support from the cited combination of references.

Examiner respectfully disagrees. Claim 18 states identifying content in response to the comparing step of the new content with the existing content. It is very obvious within the state of the art that the next logical step would be to identify the content resulting from the comparison.

Applicant argues that the references do not provide support for the elements of the preference settings and the confirmation.

Examiner respectfully disagrees. The confirmation can be found within LaRue at par [0194], and the discussion of preference settings can be found within LaRue at par [0140].

Applicant argues, claim 10 includes means plus function limitations that should have been interpreted in view of the specification as required by In re Donaldson, and thus lacks proper foundation.

Examiner respectfully disagrees. Applicant's argument are deemed improper because "If the functionally-defined disclosed means and their equivalents are so broad

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that they encompass any and every means for performing the recited functions...the burden must be placed on the applicant to demonstrate that the claims are truly drawn to specific apparatus distinct from other apparatus capable of performing the identical functions ”); *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 229 (CCPA 1971) (a case in which the court treated as improper a rejection under 35 U.S.C. 112, second paragraph, of functional language, but noted that “where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristics relied on ”); and *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980) (a case indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103). Applicant has failed to point out specific examples within their own specification of the exact means for each function discussed within independent claim 10 and even further details of how the prior art used does not provide adequate support for such means. As a result, the examiner believes the limitations for the means plus function language has been met.

Applicant's arguments with respect to the newly amended claims with reference to the content including image content has been considered but are moot in view of the new ground(s) of rejection.

Applicant argues with respect to claims 10, 17, and 24, fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHELCIE DAYE whose telephone number is (571) 272-3891. The examiner can normally be reached on M-F, 7:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Apu Mofiz can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chelcie Daye
Patent Examiner
Technology Center 2100
April 23, 2011

/Apu M Mofiz/
Supervisory Patent Examiner, Art Unit 2161